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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,587	10/23/2001	Seiya Motomiya	6667/24 (LTC-16-US)	6477

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EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

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DATE MAILED: 12/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/037,587

Applicant(s)

MOTOMIYA, SEIYA

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to for the use of legal phraseology. The use of "comprising" and "means" is improper. Proper clarification and/or correction are required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The phrase, "being formed by means of thermal transfer printing," is a process limitation and given little to no patentable weight in an article claim. The Examiner suggests rewording the claim in accordance with MPEP Sections 2181-2184 such that the claim contains a means plus

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function lending patentable weight to the aforementioned limitation. Proper clarification and/or correction are required.

6. Claim 1 is further rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The term, “fixed or variable information,” is indefinite. It is unclear what the applicant intends the aforementioned limitation to include, i.e., what is fixed or variable information? Proper clarification and/or correction are required.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. It is unclear whether the Applicant is intending the claim to be dependent upon claim 1 or whether the Applicant is intending Claim 2 to be an independent claim. If dependent, the claim structure is improper – the claim should be amended to include the dependency upon claim 1 at the top of the claim. If independent, all of the limitations of the release sheet from claim 1 need to be incorporated into the claim – it is improper for an independent claim to state, “wherein the release sheet according to claim 1.” Proper clarification and/or correction are required.

8. Claim 2 is further rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The phrase, “adapted to,” is indefinite. Either the PSA label is stuck onto a release sheet or it is not. Proper clarification and/or correction are required.

9. Claim 2 is further rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrase, “wherein the release sheet according to claim 1 is stuck onto the pressure

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sensitive adhesive layer through the releasing agent layer so that the printing layer faces the pressure sensitive adhesive layer,” is indefinite. It is unclear whether both the adhesive layer and the releasing agent layer both comprise distinct printing layers or if there is only one printing layer between the adhesive and releasing agent layers. Proper clarification and/or correction are required.

10. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The phrase, “having a release sheet,” is indefinite. It is unclear whether the Applicant intends this language to be open or closed language. The Examiner suggests replacing “having” with either “comprising,” “consisting of,” or “consisting essentially of,” in order to facilitate clarity. Proper clarification and/or correction are required.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gosselin et al. (#5,885,677).

Gosselin et al. disclose a pressure sensitive adhesive label for indicating information (see Abstract; Col. 2, lines 54-55), the pressure sensitive adhesive label constructed such that it is stuck onto a release sheet with a printed layer before the pressure sensitive adhesive label is used

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(Col. 2, lines 31-37). The label comprises a release sheet with a release sheet base (Col. 4, lines 44-46), a releasing agent layer provided on one of the surfaces of the release sheet base (Col. 4, lines 46-47), and a printed layer provided on the releasing agent layer wherein the printed layer has fixed and/or variable information and is formed via thermal transfer printing (“barrier medium”; Col. 5, lines 36-46; Col. 6, lines 40-43). The label further comprises a label base (Col. 1, lines 55-56; Fig. 1, #21) and a pressure sensitive adhesive layer provided on one of the surface of the label base (Col. 1, lines 56-57; Fig. 1, #26). The printing layer on the release sheet faces the pressure sensitive adhesive layer (see Fig. 1, #s 22 and 26). The pressure sensitive adhesive layer contains a fluorescent dye (Col. 4, lines 59-60). Gosselin et al. further disclose a method of making the pressure sensitive adhesive label wherein a release sheet is prepared with a releasing agent layer and subsequently printed with a printing layer via thermal transfer printing (Col. 5, lines 54-56). A pressure sensitive adhesive label is then prepared and stuck onto the releasing agent layer of the release sheet such that the printed layer faces the pressure sensitive adhesive layer (Col. 5, lines 47-51 and 56-58). Ultimately, the pressure sensitive adhesive label is removed from the release sheet and transferred to a substrate (Col. 5, lines 59-62).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. ('677) in view of the Applicant's admitted prior art (see Specification, p.12).

Gosselin et al. teach a pressure sensitive adhesive label as detailed above. Gosselin et al. fail to teach the printing layer to include a metallic layer.

The Applicant's admission, however, explicitly states that printing films comprising metallic layers are well known in the art and state that Murata Kimpaku Co., Ltd. of Japan provide a printing film encompassing the desired properties (see p. 12). The metallic printing layer is used for the purpose of providing the label with a printing layer that is easily transferable between the release liner and the adhesive when the adhesive is removed from the release liner (see p. 12). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have modified a printing layer in a security label to include a metallic layer for the purpose of providing the label with a printing layer that is easily transferable between the release liner and the adhesive as disclosed by the Applicant.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Gosselin et al. to include a notoriously well known metal printing film such as the one sold by Murata Kimpaku Co., Ltd. in order to provide a label with a printing layer that is easily transferable between the release liner and the adhesive. Gosselin et al. provide motivation towards making such a modification since Gosselin et al. teach that the printing layer ("barrier medium") is to be selected such that the printing layer has a lower adhesion to the release liner than the adhesive layer (Col. 4, lines 47-50).

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15. Claims 3 and 5 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. ('677) in view of Yamano et al. (#4,775,786).

Gosselin et al. teach a pressure sensitive adhesive label as detailed above. Gosselin et al. fail to teach the use of a metallic layer in the printed layer.

Yamano et al., however, teach the use of a metallic layer in a pressure sensitive adhesive label printing layer (Col. 2, lines 19-25) wherein the label is printed via transfer printing (Col. 2, lines 41-44). Yamano et al. teach the use of metallic layers in a pressure sensitive adhesive label for the purpose of providing a barcode that comprises a color that contrasts sharply from the color of the substrate (Col. 2, lines 32-39) and to provide a barcode that is excellent in high-temperature durability and chemical resistance (Col. 1, lines 46-54). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have modified a barcode to include a metallic printing layer for the purpose of providing a barcode that comprises a color that contrasts sharply from the color of the substrate and to provide a barcode that is excellent in high-temperature durability and chemical resistance as taught by Yamano et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Gosselin et al., motivated by the fact that the printing layer of Gosselin et al. is a barcode in some embodiments (Col. 2, lines 54-55), to include a metallic layer within the printing layer as taught by Yamano et al. in order to provide a barcode that comprises a color that contrasts sharply from the color of the substrate and to provide a barcode that is excellent in high temperature durability and chemical resistance.



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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE  
December 24, 2002



HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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12/24/02